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| 26712 | 7590 | 09/03/2008 | EXAMINER | |
| HODGSON RUSS LLP | | | CHAWLA, JYOTI | |
| THE GUARANTY BUILDING | | | ART UNIT | |
| 140 PEARL STREET | | | PAPER NUMBER | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/805,779

Applicant(s)

JOSEPH ET AL.

Examiner

JYOTI CHAWLA

Art Unit

1794

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 30 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 16-27 is/are pending in the application.
- 4a) Of the above claim(s) 16-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-856)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Applicant's submission mailed May 30, 2008 has been entered. Claim 1 has been amended and claim 15 has been cancelled. Claims 1-14 and 16-27 are pending. Claims 16-27 have been withdrawn from consideration for being directed to non-elected invention. Elected claims 1-14 are examined in the present office action.

Claim Rejections - 35 USC § 112

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Rejection of claims 1-15 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the percentage of components of whippable composition in independent claim 1, have been withdrawn based on applicant's amendments of May 30, 2008.

Further, rejection of claim 15, under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements has been withdrawn based on cancellation of claim 15 by the applicant.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

(A) Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lynch (US 6203841).

References and rejections are incorporated herein and as cited in the office action mailed 12/12/2007.

Regarding the amendments to independent claim 1, Lynch teaches of whippable food compositions comprising of about 31% triglyceridic fats (Column 20, lines 25-45) as instantly claimed. Lynch also teaches of 0.1 to 5% emulsifiers, such as, polysorbate 60, and polysorbitan mono and distearate which include Polysorbate 80 and sodium steryl lactylate and various combinations as instantly claimed (Column 9, line 15 to Column 10, line 5). Lynch also teaches of 0 -2% stabilizers and bulking agents and hydrophilic colloids (Column 9, lines 40-55) as instantly claimed. Lynch further teaches that the whippable composition that is smooth, non-greasy texture and free of waxy mouthfeel (Columns 10-12 and claim 26), as instantly claimed.

The amendment to claim 1 states that "wherein the whipped confection behaves as an oil-in-water emulsion, but if whipped with added sugar, behaves as water-in-oil emulsion". Regarding the amendment, it is noted that the newly added limitations are details of the properties of whipped confection made from the composition of claim 1, i.e., the newly added limitation is an intended use of the composition and the intended use does not determine the patentability of the composition. Lynch teaches a whippable composition, which is an oil-in-water emulsion (Column 15, lines 13-16), i.e., the composition as recited in claim 1 as discussed above. Lynch also teaches of adding sugar or sweetening components, such as corn syrup (Column 15, lines 18-25 and 50-65 and Column 9, line 50-55). Furthermore, Lynch's composition upon whipping produces a butter-crème type icing or coating products (i.e., water-in-oil emulsion) that are stable at about 80°F (Columns 15- 28, examples). Since, Lynch teaches of whippable composition in applicant's recited range, therefore, it would have been

obvious to one of ordinary skill in the art at the time of the invention that the composition as taught by Lynch, upon whipping under similar conditions as adopted by the applicant would result in a product with similar emulsion properties as recited by the applicant, absent any clear and convincing evidence and /or arguments to the contrary.

Regarding applicant's argument that addition of Polysorbate 60 and Polysorbate 80 together would not have been obvious to one of ordinary skill at the time of the invention (Pages 7-8), applicant is referred to the previous office action of 12/12/2007 (Page4, paragraph 2) and Lynch (Column 9, lines 25-40), wherein Lynch teaches of addition of combination of emulsifiers. Regarding the emulsifiers, Lynch teaches of polysorbate 60 and polyoxyethylene ethers of fatty esters of polyhydric alcohols, which included polyethoxylated sorbitan and fatty acid, such as oleic acid. Polysorbate 80 is derived from polyethoxylated sorbitan and oleic acid. Thus the reference taught of polysorbate 60 and other emulsifiers like polysorbate 80. In order to provide evidence that combination of Polysorbate 60 and Polysorbate 80 was known to be used in preparation of whippable compositions at the time of the invention; the office includes Petricca (US 4107343, IDS reference) as evidence. Petricca teaches of whippable emulsion with both Polysorbate 60 and polysorbate 80 as emulsifiers (Column 5, lines 60-62). This supports the position of the office, that one of ordinary skill in the art, at the time the invention was made would have been motivated to include a combination of polysorbate 60 and polysorbate 80 together in a whippable composition as taught by Lynch.

Response to Amendment

The Declaration of Andrew Fendinger, under 37 CFR 1.132 filed May 30, 2008 is insufficient to overcome the rejection of claims 1-14 based upon Lynch (US 6203841 B1) as set forth in the last Office action because:

1. The product of Lynch was prepared by the process described in lines 17-21 of 841 patent, however, the Declaration does not specify which of the 28 columns, do the line numbers apply to as Lynch reference teaches of icings, fillings, toppings, pies, cakes, whipped topping and mousse etc (Columns 15 to Columns 28).
2. The composition described by Lynch in Column 20, lines 25-45, is compared to composition disclosed in Table 2, page 5 of the publication of application, where the compositions differ significantly in the amount of water.
3. The method or process of obtaining the products from the two compositions are different, e.g., Lynch's composition is processed into a whipped product by a method disclosed by lynch and an exemplary composition of the claimed invention is prepared by a method disclosed by the applicant. The two methods differ significantly e.g., Lynch's composition is heated to 115-120°F, whereas the inventive composition is heated to 190°F (Pages 1-2 of declaration).
Further it is noted that claims 1-14 recite a composition and not a method of preparation, therefore, in order for the comparison of both compositions to be convincing, both compositions need to be prepared by following identical method steps.
4. Regarding the comparison of two compositions in terms of whipping time and performance in water, it is noted that, none of these features that are compared have been recited in the rejected claims 1-14.

Therefore, the declaration of Andrew Fendinger, under 37 CFR 1.132 filed May 30, 2008 has been fully considered, however, the evidence has not been found convincing to overcome the rejection of composition recited in claims 1-14 under 35 USC 103.

Response to Arguments

Applicant's arguments filed May 30, 2008 have been fully considered but they are not persuasive.

Applicant's remarks, pages 7-8, discuss the details of the declaration, which has been responded above under response to amendment.

In response to applicant's argument that Lynch reference fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "if both polysorbate 60 and polysorbate 80 are not used, then rosette time is decreased from 1 hour to 15 minutes" Page 7, paragraph 2, lines 4-5) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding the statement "Further, the claims as amended require that the present product be capable of undergoing inversion (i.e., behaves as an oil-in-water emulsion, but in the presence of added sugar, behaves as a water-in-oil emulsion)", it is noted that inversion is a property of the of the whipped composition, where the process steps affect the outcome of the finished product, however, the claims recite a whippable product, i.e., a product or a composition that is capable of being whipped. Lynch teaches the composition as recited, thus it would be obvious to one of ordinary skill at the time of the invention that similar compositions, identically processed would yield comparable or similar products, absent any clear and convincing evidence and arguments to the contrary.

Regarding applicant's comment "Applicants believe that it is the combination of the fat percentages between 30 and 40% and the presence of both polysorbate 60 and polysorbate 80 at the recited percentages that contributes to the product having this property." (Page 7, paragraph 3), applicant is referred that the co-action of the two emulsifiers with specific proportion of fat as per applicant's belief, is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Therefore, applicant's arguments filed May 30, 2008 have been fully considered but they are not persuasive and the rejections of claims 1-14 are maintained for the reasons of record.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTI CHAWLA whose telephone number is (571)272-8212. The examiner can normally be reached on 9:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JC
Examiner
Art Unit 1794

/KEITH D. HENDRICKS/

Supervisory Patent Examiner, Art Unit 1794